

REMARKS/ARGUMENTS

Initially, Applicants would like to express appreciation to the Examiner for the detailed Official Action provided, for the acknowledgment of Applicants' Information Disclosure Statement by return of the Form PTO-1449, for the acknowledgment of Applicants Claim for Priority and receipt of the certified copy of the priority document in the Official Action, and for acknowledging that the drawings are acceptable.

Applicants also note that the box on the Office Action Summary Sheet which indicates that the oath/declaration has been objected to is checked. However, Applicants note that in the body of the Official Action the Examiner has NOT indicated that the oath/declaration has been objected to, and Applicants have not received a Form PTO-152 indicating that the oath/declaration has been objected to. Further, Applicants Representative has reviewed the oath/declaration and has found no errors therein. Therefore, Applicants presume that the aforementioned box has been inadvertently checked. Accordingly, Applicants respectfully request that the Examiner indicated that the oath is acceptable in the next Official communication.

Upon entry of the above amendments claims 1-12 will have been amended. Claims 1-12 are currently pending. Applicants respectfully request reconsideration of the outstanding rejections, and allowance of all the claims pending in the present application.

In the Official Action, the Examiner has rejected claims 1, 3 and 5-7 under 35 U.S.C. § 102(e) as being anticipated by KURIHARA et al. (U.S. Patent Pub. No. 20030086800).

Without acquiescing to the propriety of the Examiner's rejection, Applicants have amended independent claim 1 solely in order to expedite prosecution of the present application. In this regard, Applicants note that KURIHARA fails to teach or suggest the combination of elements as recited in claim 1. In particular, claim 1 sets forth an electric compressor including, inter alia, an intake passage which returns fluid from an outside of said compressor into said suction port, wherein said suction port is provided in said inverter case, and wherein said intake passage has a thermal binding portion which thermally binds said intake passage to said inverter, the thermal binding portion having a plurality of fins projecting into a fluid path of the intake passage.

Applicants submit that KURIHARA lacks any disclosure of at least the above noted combination of elements.

In this regard, the Examiner asserts that KURIHARA discloses a compressor having a compression portion (20), a motor (30), and a housing divided into an inverter attachment side (11), and another side (13). More particularly, the Examiner asserts that the partition wall (11b) acts as a thermal binding portion. However, Applicants note that the thermal binding portion of the present claimed invention is structurally different from the device of KURIHARA. In particular, Applicants submit that KURIHARA discloses a partition wall (11b)

[which the Examiner considers to be a thermal binding portion] having a flat surface, and a cylindrical projection (11d)[for supporting the drive shaft] attached thereto. Therefore, KURIHARA does not disclose at least a thermal binding portion having a plurality of fins projecting into a fluid path of the intake passage.

Further, Applicants note that absent a disclosure in a single reference of each and every element recited in a claim, a *prima facie* case of anticipation cannot be made under 35 U.S.C. § 102. Since the applied reference fails to disclose each and every element recited in independent claim 1, as well as claims 3 and 5-7, dependent therefrom, these claims are not anticipated thereby. Further, all pending dependent claims recite additional features that further define the present invention over the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection under 35 U.S.C. § 102 and allow all pending claims in the present application.

In the Official Action, the Examiner has rejected claims 2, 8, and 10-12 under 35 U.S.C. § 103(a) as being unpatentable over KURIHARA; and claims 4 and 9 as being unpatentable over KURIHARA in view of MAKINO et al. (U.S. Patent No. 6,808,372).

In regard to the rejection of claim 2, without acquiescing to the propriety of the Examiner's rejection, Applicants have amended independent claim 2 solely in order to expedite prosecution of the present application. In this regard, Applicants note that KURIHARA fails to teach or suggest the combination of elements as recited in claim 2. In particular, claim 2 sets forth an electric compressor

including, inter alia, an intake passage which returns fluid to, wherein said suction port is provided in said inverter case, and wherein said intake passage has a thermal binding portion which thermally binds said intake passage to said inverter, wherein an air layer is provided between said intake passage and said end wall, and wherein the thermal binding portion has a plurality of fins projecting into a fluid path of the intake passage.

Applicants submit that KURIHARA, alone or in any proper combination, lacks any disclosure of at least the above noted combination of elements.

In this regard, the Examiner acknowledges that KURIHARA does not disclose the inverter case being externally attached to an end wall of the housing on a discharge side of the compression mechanism. Nevertheless, the Examiner takes the position that modifying KURIHARA to include the aforementioned feature is merely an obvious rearrangement of parts. However, as discussed supra, KURIHARA also does not disclose a thermal binding portion having a plurality of fins projecting into a fluid path of the intake passage. Therefore, independent claim 2 is allowable for at least reasons generally similar to claim 1, as argued supra.

Additionally, the Examiner cites to only a portion of MPEP § 2144.06(c) in support of the assertion that attaching the inverter case to a discharge of the compression mechanism is merely an obvious rearrangement of parts. More particularly, in the Examiner's opinion, shifting the inverter case from the suction side to the discharge side would not modify the operation of the compressor

system. However, in the Official Action, the Examiner omits the portion of MPEP § 2144.06(c) which makes clear that "[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

In this regard, Applicants submit that the Examiner has not indicated where of how the prior art provides motivation for the suggested modification. Therefore, the Examiner has not presented sufficient motivation for the proposed modification, and the only reason to modify the teachings of the applied prior art results from a review of Applicants' disclosure and the application of impermissible hindsight.

In regard to the rejection of claims 4 and 8-12, Applicants respectfully traverse the rejection of these claims under 35 U.S.C. § 103(a).

In this regard, Applicants submit that dependent claims 4 and 8-12 are at least patentable due to their respective dependencies from claims 1 and 2 for the reasons noted above. In this regard, Applicants note that the Examiner has provided no explanation or motivation for correcting the above-noted deficiencies in the teachings of KURIHARA. Applicants further submit that neither the Examiner's assertion of an obvious rearrangement of parts nor the asserted

disclosure of MAKINO provide any teachings which could reasonably be characterized as curing the above-noted deficiencies in the teachings of KURIHARA. In this regard, Applicants submits that none of the applied prior art disclose at least the present claimed thermal binding portion having a plurality of fins projecting into a fluid path of the intake passage

Further, in regard to the rejection of claims 2, 8, and 10-12, the Examiner asserts that externally attaching the inverter case to an end wall of the housing on a discharge side of the compression mechanism is merely an obvious rearrangement of parts. However, Applicants submit that the Examiner has not provided any factual evidence to support the aforementioned assertion. Therefore, if the Examiner decides to maintain the aforementioned basis of rejection, Applicants respectfully request that the Examiner provide an appropriate teaching reference indicating the same. Accordingly, the rejections of claims 4 and 8-12 under 35 U.S.C. § 103(a) is improper and should be withdrawn.

In view of the amendments and arguments herein, Applicants submit that independent claims 1 and 2 are in condition for allowance. With regard to dependent claims 3-12 Applicants assert that they are allowable on their own merit, as well as because of their respective dependencies from independent claims 1 and 3, which Applicants have shown to be allowable.

Thus, it is respectfully submitted that all of the claims in the present application are clearly patentable over the references cited by the Examiner, either

alone or in combination, and an indication to such effect is respectfully requested,
in due course.

SUMMARY

Applicants submit that the present application is in condition for allowance, and respectfully request an indication to that effect. Applicants has argued the allowability of the claims and pointed out deficiencies of the applied references. Accordingly, reconsideration of the outstanding Official Action and allowance of the present application and all the claims therein are respectfully requested and is now believed to be appropriate.

Applicants note that this amendment is being made to advance prosecution of the application to allowance, and should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability.

Should the Examiner have any questions, the Examiner is invited to contact
the undersigned at the below-listed telephone number.

Respectfully submitted,
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